

82. (Amended) A method for applying make-up to the skin and/or the keratinous fibres, comprising applying to the skin and/or the keratinous fibres, a solid aqueous gel comprising: i) at least one hydrophilic gelling agent, ii) at least one cellulose derivative, and iii) a pulverulent phase comprising at least one component chosen from pigments and pearlescent agents, wherein the combination of the hydrophilic gelling agent and the cellulose derivative is present in the gel in an amount ranging up to 20% by weight, relative to the total weight of the gel.

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**REMARKS**

***Preliminary Amendment***

In the present amendment, claim 82 is amended, and no claims are cancelled or added. Claims 27-83 are pending in the application.

By this amendment, Applicant amends claim 82 to change "rivative" to --- derivative---, to correct a typographical error. Support for this amendment is found, e.g., in originally filed claim 1. Accordingly, no new matter has been added by the amendments and no estoppels are intended thereby.

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***Response to Restriction and Election of Species Requirement***

In response to the Restriction and Election of Species Requirement dated September 25, 2002, reconsideration in view of the following remarks is respectfully requested.

In the Restriction and Election of Species Requirement, the Office has required restriction under 35 U.S.C. § 121 between the following groups of claims:

- I. Claims 27-81, drawn to a solid aqueous gel; and
- II. Claims 82-83, drawn to a method of making up.

In response, Applicant hereby elects Group I, claims 27-81, with traverse.

Additionally, the Office has required an election of species. In particular, the Office has required an election of a single species of a hydrophilic gelling agent.

As the species, Applicant elects gellan gum. At least claims 27, 28, 30, 33, 37-83 read on the elected invention.

Applicants submit that the Restriction Requirement is inappropriate in this case. Importantly, since this application is the national stage of a PCT application filed under 35 U.S.C. § 371, unity of invention rules apply.

As recognized by the Examiner, when the PTO considers international applications during the national stage under 35 U.S.C. § 371, PCT Rules 13.1 and 13.2 will be followed when considering the unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. § 111.

According to PCT Rule 13.2, unity of invention exists when there is a technical relationship among the claimed inventions involving one or more technical features. Specifically, M.P.E.P. § 1850 states that PCT Rule 13 shall be construed as permitting

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inclusion in the same application of "an independent claim for a given product" with "an independent claim for a use of the said product . . . ."

Under the facts of the present case, Example 1 of the PCT Administrative Instructions is particularly relevant:

Claim 1: A method of manufacturing chemical substance X.

Claim 2: Substance X.

Claim 3: The use of substance X as an insecticide.

Unity exists between claims 1, 2, and 3. The special technical feature common to all the claims is substance X.

Administrative Instructions under the PCT, Annex B, Part 2.

In the present case, the claims of Group I recite a solid aqueous gel, and the method claims of Group II involve a method for applying make-up that uses the solid aqueous gel. Unity exists between Groups I and II, **because a special technical feature common to all the claims is a:**

. . . solid aqueous gel comprising: i) at least one hydrophilic gelling agent, ii) at least one cellulose derivative, and iii) a pulverulent phase comprising at least one component chosen from pigments and pearlescent agents, wherein the combination of the hydrophilic gelling agent and the cellulose derivative is present in the gel in an amount ranging up to 20% by weight, relative to the total weight of the gel.

See e.g., independent claims 27, 80, 81, 82, and 83. Since the present Restriction Requirement involves restricting between claims for a given product and method claims for the use of the product, the claims should be examined in the same application, as required by M.P.E.P. § 1850(C). Thus, the Restriction Requirement should be withdrawn.

The Office asserts that U.S. Patent No. 5,286,755 to *Kauffmann et al.* teaches "the formation of aqueous gels reading on claim 27" and "is direct evidence that the invention is not a contribution over the art when considered as a whole as claimed." Restriction Requirement at page 2.

In response, Applicant notes that *Kauffmann* is not being used to reject the present invention. In any event, Applicant submits that the present invention is a contribution to the art over *Kauffmann*, such that the Restriction Requirement should be withdrawn.

Applicant traverses the Restriction and Election of Species Requirement on the grounds that the Office has not shown that there would be a serious burden to examine all of the pending claims together. In fact, the Office has failed to allege that any such burden exists.

Even if the Restriction Requirement is maintained, if product claims are found to be patentable, withdrawn process claims which include the recitations of the product claims should be rejoined. The Office is reminded that M.P.E.P. § 821.04 states:

However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of an allowable product claim will be rejoined.

Thus, if product claims are found to be allowable, the process claims of Group II which include the composition recitations of the allowed product claims should be rejoined.

Further, if the Office chooses to maintain the Election of Species Requirement, and if the elected species is found allowable, Applicant expects that the Office will continue to examine the full scope of at least claims 27-81 to the extent necessary to

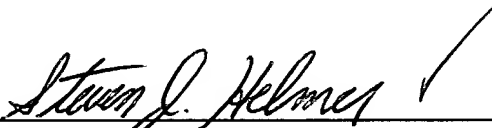
determine the patentability of these pending claims, i.e., extending the search to a reasonable number of the non-elected species, as is the duty according to M.P.E.P. § 803.02 and 35 U.S.C. § 121.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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**APPENDIX**

82. (Amended) A method for applying make-up to the skin and/or the keratinous fibres, comprising applying to the skin and/or the keratinous fibres, a solid aqueous gel comprising: i) at least one hydrophilic gelling agent, ii) at least one cellulose [rivative] derivative, and iii) a pulverulent phase comprising at least one component chosen from pigments and pearlescent agents, wherein the combination of the hydrophilic gelling agent and the cellulose derivative is present in the gel in an amount ranging up to 20% by weight, relative to the total weight of the gel.

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